FILE COPY

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1935.

No. 590.

THE MANTLE LAMP COMPANY OF AMERICA,

VS.

ALUMINUM PRODUCTS COMPANY.

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF OF APPELLEE.

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ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF OF APPELLEE.

This cause is before this Court upon a certificate from the United States Circuit Court of Appeals for the Seventh Circuit relative to disclaimers in patent cases. The Mantle Lamp Company of America having designated itself as appellant throughout its brief, the same distinction will be maintained throughout this brief of Aluminum Products Company, defendant in the lower court.

Opinions Below.

There are no published opinions of the Courts below. Certain of the findings of fact and a conclusion of law of the District Court in so far as they are pertinent to disclaimers appear in the Record, page 2. This certificate is before this Court prior to the filing of an opinion in this cause by the Circuit Court of Appeals for the Seventh Circuit.

Opinions in other cases having an important bearing upon the questions certified are as follows:

1. *Macomb Manufacturing Company* v. *The Mantle Lamp Company of America,* 22 F. (2d) 93 (C. C. A. 7).

2. *Monarch Company, Inc., et al.* v. *The Mantle Lamp Company of America,* 22 F. (2d) 95 (C. C. A. 7).

3. *The Mantle Lamp Company of America* v. *The George H. Bowman Company,* 53 F. (2d) 441 (C. C. A. 6).

Jurisdiction.

For jurisdiction of this certificate and the questions therein certified Section 239 of the Judicial Code, as amended; 28 U. S. C. A. 346, is relied upon.

Statement of the Case.

This suit was brought to recover damages and profits occasioned by the alleged infringement of letters patent No. 1,435,199 issued to appellant as assignee of Lewis Van DeVenter Blair for Heat-Insulated Receptacle.

The District Court rendered findings of fact and con-

clusions of law for the appellee and entered a decree dismissing the bill of complaint for want of equity. From that decree an appeal was taken to the United States Circuit Court of Appeals for the Seventh Circuit. After the submission of briefs and argument by counsel, the United States Circuit Court of Appeals for the Seventh Circuit has certified to this Court the several questions relative to disclaimers appearing at the end of this certificate and upon which the Circuit Court of Appeals desires instruction and advice.

The facts necessary to a decision of certified questions Nos. 1 and 2 are simple. Appellant is owner of a patent containing, for the purposes of the present discussion, two groups of claims, which, for convenience of reference as hereinafter more fully set forth, may be denominated A and B. The claims in group A were involved in two suits against parties other than appellant in the District Court for the Southern District of Illinois, Northern Division, and the District Court for the Northern District of Illinois, Eastern Division, respectively.

On appeal the decrees in those cases were reversed and all of the claims in suit, or group A claims, were held to be invalid. *Macomb Manufacturing Company* v. *The Mantle Lamp Company of America*, 22 F. (2d) 93, *Monarch Company, Inc. and Therm-A-Jug Company, Inc.* v. *The Mantle Lamp Company of America*, 22 F. (2d) 95 (R., pp. 2-3). Petitions for rehearing were denied and the mandates issued December 5, 1927. No petition for certiorari was filed in either case. No further effort was made to establish the validity of the claims in those suits (R., p. 3).

Four years and eleven months later, without disclaimers having been filed, appellant brought suit in

the District Court for the Northern District of Illinois, Eastern Division, against appellee for infringement of the claims of group A previously held invalid, as well as certain additional claims embraced in group B. The latter claims had not theretofore been passed upon by the courts of that Circuit or any Circuit Court of Appeals (R., p. 1).

The failure to file disclaimers was set up as a defense in appellee's answer, and, in dismissing the bill of complaint for want of equity, the District Court in the present suit, among other conclusions of law, held that each of the claims of the patent was invalid for unreasonable delay and neglect for filing disclaimers to the claims formerly held invalid (R., p. 2).

Appellant appealed from the decree dismissing the bill for want of equity and the case is now before this Court upon the questions certified.

For the purpose of deciding question No. 3 it will be necessary to consider that during the pendency of the first two suits appellant had brought suit in the Eighth Circuit against a customer (Cutino Company) of a defendant (Monarch Company, Inc.) in one of the earlier suits. Following the holding of invalidity of the group A claims the defendant, Monarch Company, Inc., procured a preliminary injunction restraining appellant from proceeding further in the Eighth Circuit suit against the defendant's customers (R., p. 3).

Shortly after the holding of invalidity of the group A claims by the Court of Appeals for the Seventh Circuit, and before the institution of the present suit, appellant brought suit in the District Court for the Northern District of Ohio, Eastern Division (*Mantle Lamp Company of America* v. *George H. Bowman Company*) upon group A claims plus one of the claims of group B. That court in an unreported decision, following

the Seventh Circuit decision, held all of the claims in suit to be invalid. Upon appeal the District Court was reversed (53 F. (2d) 441) as to claim 1 of group A which claim was held valid and infringed without prejudice to the remaining claims (R., pp. 4-5).

Other than the filing of an answer the defendant in the Sixth Circuit case functioned no further. It did not appear at the trial. It took no proofs. Plaintiff voluntarily put in evidence all the patents set up in the Answer. Upon the appeal the defendant did not appear. The question of failure to file disclaimers was not raised or even considered (53 F. (2d) 441). The case was substantially an *ex parte* proceeding. Appellant filed a petition for writ of certiorari in the Supreme Court to the Circuit Court of Appeals for the Sixth Circuit and this was denied. (R., p. 4; 285 U. S. 545.)

Four years and eleven months elapsed between the decision of invalidity of the group A claims in the Seventh Circuit and the institution of the present suit against appellee, during which the aforesaid proceedings took place.

The facts as to the pendency of the Bowman case are relied upon most strongly by appellant to excuse the delay in filing disclaimers if the disclaimer statutes are found to apply to the facts outlined herein, or to show that the period of delay has not yet begun to run (Appellee's Brief, Points II-III, pp. 9-26).

This is not a case where the whole patent was held invalid in the first suits (R., pp. 2-3). It is a case where appellant is attempting to maintain a suit on claims not previously held invalid without having disclaimed claims previously held invalid (R., p. 2).

Questions Presented.

The questions concerning which the Circuit Court of Appeals desires the instruction and advice of the Supreme Court of the United States are as follows:

"1. Where certain but not all of the claims of a patent are in suit, and all of the claims in suit are held and decreed to be invalid pursuant to a finding and judgment to that effect of the Circuit Court of Appeals of the circuit, may the owner of the patent maintain a suit afterward brought thereon in the same judicial circuit as that in which the first cause was decided, and against a different defendant not involved in the first suit—the second suit being based on the claims held in the prior suit to be invalid and on other claims of the same patent not previously adjudicated—where the owner of the patent wholly failed and omitted to file any disclaimer of the claims held in the first suit to be invalid, and where, between entry of decree of invalidity of the claims in the first suit and the bringing of the second suit in the same circuit, reasonable time had elapsed for filing such disclaimer?

"2. If question (1) is answered in the affirmative does the intervention of a period of approximately five years between the final judgment in the first suit and the institution in the same circuit of the second suit constitute delay so unreasonable as to bar the second suit for want of disclaimer of the claims which had been held to be invalid?

"3. If question (2) is answered affirmatively, may the institution or pendency of other suits in another judicial circuit or circuits after entry of final decree in the first suit, based on claims of the patent so held invalid and on other claims thereof not previously adjudicated to be invalid, excuse the failure to file disclaimer of the claims held invalid prior to instituting the later suit in the same circuit?"

The Statutes Involved.

The statutes involved are those directed to disclaimers in patent cases and appear as R. S. Section 4917; 35 U. S. C. A. 65 and R. S. Section 4922, 35 U. S. C. A. 71. These statutes may be found in the Appendix attached to this brief.

Introduction to Argument.

Appellant's contentions are based upon two main propositions:

1. The disclaimer statutes have no application to the facts of this record.

2. If the disclaimer statutes are applicable to the facts of this record these facts also excuse the delay or failure to file disclaimers.

Appellee's argument is based primarily upon the fact that the disclaimer statutes are applicable to the facts of this record and that the facts in the case of *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445; 51 Sup. Ct. 207, are paralleled by the facts of this case with certain exceptions where such facts show an even further disregard of the disclaimer statutes.

Prior to the passage of the disclaimer statutes, when one claim of a patent was held to be invalid by a court of competent jurisdiction and the patentee could not go to a higher court, or would not go to a higher court, the entire patent became void. (*Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445; 51 Sup. Ct. 207.) The disclaimer statutes were passed so as to permit such patentee to bring other suits, under certain circumstances, upon those parts of the patent not previously held void—

"But no patentee shall be entitled to the benefits of this Section if he has unreasonably neglected or delayed to enter a disclaimer."

(R. S. 4922, 35 U. S. C. A. 71.)

These disclaimer statutes do not in so many words prevent a patentee whose entire patent has been judicially declared invalid from entering another circuit and attempting to save something from that patent through another judicial determination. We do not have that state of facts in the instant case. Nor do the disclaimer statutes specifically forbid a patentee who has had certain claims of his patent declared invalid from entering another circuit upon those specific claims in an attempt to save something from those invalid claims. Neither does this state of facts exist in the instant case.

The disclaimer statutes do say, substantially, that where claims of a patent are held invalid and something still remains in the patent in the form of other claims the patentee may maintain a suit on those other claims providing a disclaimer is filed to the invalid claims. Conversely, where certain claims of a patent have been held invalid a patentee may not maintain suit on other claims of that patent until a disclaimer to the invalid claims has been filed. (35 U. S. C. A. 71; R. S. 4922.)

The facts outlined in the last paragraph are broadly the facts of the case at bar, and it is submitted that the disclaimer statutes do apply.

Appellee, therefore, will show how and why the disclaimer statutes are applicable to the circumstances of this case, how the facts parallel those of the Ensten case, and how the technicalities relied upon by appellant in an attempt to excuse the delay in disclaiming, or to excuse the application of the disclaimer statutes, are really non-existent or fall by their own weight.

SUMMARY OF ARGUMENT.

Point I.

The facts of this case and the facts of the Ensten case strictly applying the disclaimer statutes parallel one another.

Ensten v. *Simon, Ascher & Co.*, 282 U. S. 445; 51 Sup. Ct. 207.

Point II.

The disclaimer statutes are applicable to the facts of this case.

35 U. S. C. A. 65; R. S. Sec. 4917.
35 U. S. C. A. 71; R. S. Sec. 4922.

Point III.

By the very wording of the disclaimer statutes they are jurisdictional in their nature.

35 U. S. C. A. 71; R. S. Sec. 4922.
Ensten v. *Simon, Ascher & Co.*, 282 U. S. 445; 51 Sup. Ct. 207.
R. Hoe & Co. v. *Goss Printing Press Co.*, 31 Fed. (2d) 565 (C. C. A. 2).
Liquid Carbonic Co. v. *Gilchrist Co.*, 253 Fed. 54; 58 (C. C. A. 7).

Point IV.

Claims held invalid for lack of invention are within the disclaimer statutes.

Point V.

Specific disclaimers to some of the claims of the patent do not affect claims remaining in the patent.

Graham v. *Earl*, 92 F. 155, 159 (C. C. A. 9).

United States Metallic Packing Co. v. *Hewitt Co.*, 236 Fed. 739, 742 (C. C. A. 7); certiorari denied 242 U. S. 651; 37 Sup. Ct. 243).

Point VI.

The technicalities urged by appellant do not take the facts of this case from within the disclaimer statutes nor excuse delay in filing disclaimers thereunder.

ARGUMENT.

Point I.

The Facts of this Case and the Facts of the Ensten Case Strictly Applying the Disclaimer Statutes Parallel One Another.

The present case involves a patent in which claims of group A (claims 1, 3, 4, 5, 6, 7, 10, 11, 12, 13, 14, 17, 18, 21, 22, 23 and 24) were held invalid. Nearly five years later appellant, without filing disclaimers, brought suit on claims of group B (claims 8 and 9) of said patent, not previously held invalid, joining the claims of group A.

In the case of *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445; 51 S. Ct. 207, there was a patent in which the claim of group A (claim 2) was held invalid and claims of group B (claims 1, 3, 4 and 5) were held valid and infringed. The patentee disclaimed group A within two years. Thereafter the patentee brought

suit in another circuit on claims of group B without joining group A theretofore disclaimed.

The differences in the facts of these cases are (1) in the Ensten case a disclaimer was filed while none was filed in the instant case; and (2) in attempting to maintain the later suit upon the claims of group B, Ensten did not join his group A claim, while in the instant case claims of group A were joined. An important question, therefore, presents itself as to whether if Ensten had not disclaimed group A (claim 2) but had included it in the later suit, the result of that suit would have been different. It is these facts which are present in the case at bar.

Appellant says that if these are the facts it is excused from filing disclaimers by reason of what took place in the Sixth Circuit. The facts there were the same. Appellant brought suit on group B (claim 9) and joined the previously-held invalid claims of group A. The question of disclaimers not having been raised, the court did not discuss the applicability of the Ensten case. The claims of the patent would never have been considered if these facts had been called to the attention of the Circuit Court of Appeals for the Sixth Circuit. The disclaimer statute says appellant may maintain a suit on claims of group B, but he shall not be entitled to maintain such a suit if he has unreasonably neglected or delayed to enter a disclaimer of the claims of group A (R. S. 4922; 35 U. S. C. A. 71). Nothing could be clearer than the wording of this statute in view of its interpretation in the Ensten case. There are no exceptions to this rule among the cases. No suit can be maintained upon the claims of group B until the claims of group A are disclaimed.

Point II.

The Disclaimer Statutes Are Applicable to the Facts of this Case.

The historical background for the disclaimer statutes is set forth in the case of *Ensten* v. *Simon, Ascher & Co.,* 282 U. S. 445, 452, 51 S. Ct. 207, 209. To remedy the rigid common law that a patent with an invalid claim was entirely void, the disclaimer statutes, through one section, permitted a disclaimer of that part of the patent not invented by the patentee. The second section permitted the patentee to maintain a suit upon that part of his patent which he had invented provided he had first disclaimed that which he had not invented.

Nothing is said in these statutes about the maintenance of suits by the patentee upon that part of the patent judicially declared to be invalid and cases involving such facts are not pertinent to a decision of this case. The latter involves facts wherein the patentee is attempting to maintain suit upon that part of the patent not judicially declared void without disclaiming the part judicially declared void (R., p. 2). It was to assist the patentee to save a portion of his patent that the disclaimer statutes were passed. If the patentee could not maintain his suit upon what remained in his patent before the passage of the disclaimer statutes, certainly he cannot maintain a similar suit after the passage of those statutes without strictly complying therewith.

Point III.

By the Very Wording of the Disclaimer Statutes They Are Jurisdictional in Their Nature.

A study of the cases discloses that a patentee is not permitted to maintain a suit upon that portion of his patent not judicially declared invalid until he has disclaimed that portion of his patent judicially declared void. Even in the same suit where some of the claims of a patent are held void and some are upheld by a Circuit Court of Appeals, the patentee may not further maintain that suit for the purposes of an accounting until he has filed a disclaimer to the void claims (*Liquid Carbonic Co.* v. *Gilchrist,* 253 F. 54, 58; C. C. A. 7), or applied to the Supreme Court for a writ of certiorari and been vindicated, or disclaimed after the petition for said writ was denied (*Hoe & Co.* v. *Goss Printing Press Co.,* 31 F. (2d) 565; C. C. A. 2).

In the case of *Ensten* v. *Simon, Ascher & Co.,* 282 U. S. 445, 51 S. Ct. 207, the later suit in the Second Circuit was dismissed without passing upon the merits of the case because of unreasonable neglect and delay in filing disclaimers. After the Sixth Circuit suit, Ensten had applied for a preliminary injunction against Simon, Ascher & Company in the District Court for the Southern District of New York. That court not only refused a preliminary injunction but dismissed the bill for unreasonable delay in filing a disclaimer, which rulings were affirmed on appeal (38 F. (2d) 71).

The result under the decisions of these cases and other similar ones is that before a case of this nature may be maintained upon the merits, either in the same suit or in another suit, upon parts of a patent not declared invalid, the courts will first determine

whether a proper disclaimer has been filed, or whether the patentee has vindicated himself, with respect to that part of the patent held void, by appeal to a higher court or by way of writ of certiorari from the Supreme Court.

Consequently, the Circuit Court of Appeals for the Seventh Circuit is proceeding properly in this case in establishing the effect of appellant's failure to file disclaimers before it proceeds with a decision of the case upon the merits.

Point IV.

Claims Held Invalid for Lack of Invention Are Within the Disclaimer Statutes.

Appellant's play on words that "there has been no contention that Blair claimed more than he invented; the sole contention has been that he invented nothing" (Brief, p. 17) is clever but futile. If Blair invented nothing and claimed something he certainly claimed more than he invented. The nothing that Blair invented was defined by the Circuit Court of Appeals for the Seventh Circuit and is to be found in the claims of group A. Claims of group B have never been passed upon by a Circuit Court of Appeals. The something that Blair invented may be found among those claims. But unless disclaimers are filed that something cannot be saved.

The whole effect of appellant's argument in its brief is to belittle the claims of group B which have not been finally passed upon and to insist upon the claims of group A previously held void. Whether a patent is held invalid *in toto* is to be determined not by the *obiter dictum* of an opinion but by the facts and the actual decision. The patent of appellant was never

held invalid *in toto* (R., pp. 2-3). If nothing remained after claims of group A were held invalid, why was appellant maintaining a suit in the Sixth Circuit on a group B claim and why is it now maintaining a suit on group B claims (claims 8 and 9) in the Seventh Circuit?

Point V.

Specific Disclaimers to Some of the Claims of the Patent Do Not Affect Claims Remaining in the Patent.

Appellant argues that all of the material and substantial parts of the patented device were in the claims of group A, were held invalid, and nothing remains in its patent if it disclaims group A. Group B is for "minutia," says appellant. It might possibly be that the patentee, if he invented anything, invented only minutia. Claims broader than the minutia might be invalid for many reasons, including lack of invention by reason of his claiming more than he was entitled to and thereby claiming as well the prior art which he did not invent.

If at this time a patent should issue in the automobile field including a claim for "a body portion, wheels rotatably mounted on said body portion, an engine mounted on said body portion, and means operatively connecting said engine to said wheels for rotating the same upon operation of said engine," it undoubtedly would be void, in view of the prior art, for lack of invention by reason of the patentee claiming more than he invented. Suppose now his patent in addition contained claims for minutia, such as his exact means for operatively connecting the wheels to the engine, as by a certain type of shaft, or clutch,

or both together, thereby producing additionally an entirely new and different entity. If the broad claim were held to be void he would be forced to disclaim before he could sue another upon his claim for minutia. If he disclaims his broad claim does he thereby disclaim everything in his claim for minutia except his particular shaft or clutch or both? Appellant thinks so. Appellant's contention is that he has nothing left but a shaft or clutch without cooperating wheels, body or engine because these elements, as words, were mentioned in the broad claim. The entity of the claim for minutia has disappeared. By analogous reasoning, appellant (Brief 14) says that should it disclaim the claims of group A then all it would have left in claims 8 and 9 of group B is a heat-insulating air space.

Obviously the answer is that a disclaimer to a claim disclaims the particular combination of that claim. Another claim with other coacting elements included therein is a separate and distinct combination and another entity. In *United States Metallic Packing Co.* v. *Hewitt Co.*, 236 Fed. 739, 742 (C. C. A. 7), the court said:

> "Clearly the second claim was disclaimed because it covered, not a ring, but an old combination of the ring and the other elements used in the stuffing box. The packing ring in this combination was described only as composed of interlocking segments and formed with a conical end. Obviously neither this claim nor its disclaimer can extend or limit the scope of the first claim, the only claim for a special ring construction."

In *Graham* v. *Earl*, 92 Fed. 155, 158, 159 (C. C. A. 9), the court said:

> "Claims 1 and 2 of the patent just referred to are exceedingly broad, and cover all possible

means for holding the lids of the ventilators open in oppositely inclined positions, while its claims 3 and 4 are more narrow, and cover only the specific means therein particularly described for holding such lids open. The whole argument of the plaintiff in error upon this point seems to rest upon the proposition that, as claims 1 and 2 are broad enough in their descriptive language to include the specific combinations covered by claims 3 and 4, plaintiff's disclaimer of claims 1 and 2 was, in legal effect, a disclaimer of the particular device described in claims 3 and 4; in other words, that the particular means for holding the lids of the ventilators open as described in claims 3 and 4 were thus disclaimed, because such means are covered by the broad language of claims 1 and 2.

. . . . . .

"Applying this rule of interpretation to the disclaimer filed by the plaintiff in this action, it would seem too clear to admit of any doubt that such disclaimer cannot be given the broad and sweeping effect claimed for it by the plaintiff in error. On the contrary, the only reasonable construction which can be given the disclaimer of claims 1 and 2 is that the plaintiff intended to thereby limit his patent to the specific invention described in the remaining claims of his specifications, and not to abandon such remaining claims."

The citations from Robinson on Patents by appellant (Brief, p. 16) are directed to the amendment of a claim by disclaiming a part of the claim and are not in point in the determination of the question of disclaimer as raised in this case.

In Section 650 (Volume II, p. 289) of the same work by Professor Robinson appears the following:

"The effect of a disclaimer is confined to the excess which it removes from the apparent protection of the patent. Except as to this the patent

> remains operative to the same extent as before the disclaimer was filed. The disclaimer of a void Claim does not affect such other Claims of the patent as by themselves are valid, nor does the disclaimer of the excessive portion of a Claim impair the force of what is not disclaimed."

This observation shows that Robinson realized the distinction made between disclaiming excess parts of a claim and disclaiming a whole claim of excess where other claims remain in the patent. It effectively disposes of appellant's argument that there is no such distinction, and that, with the invalidation of claims of group A, if disclaimers were filed, nothing would remain in the patent as expressed by the claims of group B.

In *Winans* v. *New York & Erie R. R. Co.*, 62 U. S. (21 How.) 88, the patent contained only one claim. (Fed. Cas. 17,863.) Consequently the language of the Supreme Court contained in appellant's statement, "that disclaimers are not involved 'where the disclaimer, to be effectual, would include the whole invention'" (Appellant's Brief, p. 15) was perfectly sound and appropriate for that case. A disclaimer of that claim would have left the patentee with nothing.

The case of *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon; Inc.*, 294 U. S. 477, 489, 490; 55 S. Ct. 455, 460, cited under appellant's Point IV, deals with circumstances where the patentee attempts to amend a claim by disclaiming a part of that claim or amends by adding elements to that claim by disclaimer, and has no bearing upon this case. For a distinction between the Altoona case and the case at bar see the cases cited in Note 2 of the report of the Altoona case.

The other cases cited under Point IV are equally not in point. One, *Gill* v. *Wells*, 89 U. S. (22 Wall.)

1, involved a reissue patent having new matter, and the other, *Vance* v. *Campbell,* 66 U. S. (1 Black.) 427, involved alleged infringement where the alleged infringing device omitted an element of a combination claim and this court refused to permit the patentee to disclaim that element of its claim or to speak of that element as immaterial or useless.

The appellant is not asked to give up one element of an entity but to give up an entire entity that does not belong to it in order to hold on to another entity that may belong to it.

Point VI.

The Technicalities Urged by Appellant Do Not Take the Facts of this Case From Within the Disclaimer Statute Nor Excuse Delay in Filing Disclaimers Thereunder.

Most of appellant's technicalities are discussed under Points III to V of this brief. Summarized they are:

1. Proposition: Where a claim has been held void for lack of invention by disclaiming that claim the patentee disclaims every element of that claim when repeated in other claims of the same patent. Citations where claims have been amended by adding or cancelling elements therefrom are set up in support of this proposition. Therefore, says appellant, when one claim is disclaimed all other claims are likewise disclaimed to the extent that they use the same elements. Consequently no disclaimer need be filed as nothing substantial is left in any of the claims.

Answer: The same argument obviously may be applied to claims whether held invalid for lack of inven-

tion, aggregation, anticipation or prior invention. The fallacy of this reasoning is shown by the cases cited in Point V of this brief.

2. Proposition: The entire patent was held void by the Circuit Court of Appeals for the Seventh Circuit (Appellant's Brief, p. 17), and, therefore, no disclaimer need be filed.

Answer: This is an extraordinary statement in view of the facts cited by the Circuit Court of Appeals in its record on this certificate (pages 2 and 3) where only certain claims, group A, are set forth as being held invalid in the earlier suits.

3. Proposition: Appellant's position as to the validity of the claims of group A was vindicated in the Sixth Circuit (Appellant's Brief, pp. 17 to 26).

Answer: Appellee submits that the Sixth Circuit suit was nothing but the maintaining of a suit upon a presumptively valid part of appellant's patent without having disclaimed the judicially-declared invalid parts of the patent and that the courts of the Sixth Circuit had no jurisdiction to pass upon the merits of the case. Appellant did not choose to vindicate its position by seeking a writ of certiorari from this Court after the early decisions of the Seventh Circuit (*Hoe & Co.* v. *Goss Printing Press Co.*, 31 F. (2d) 565) but went to another Circuit as in *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445; 51 S. Ct. 207. This is at least one breach in appellant's continuity of action. It did not even seek vindication of its position as to the invalid claims of group A alone. Though the disclaimer statutes applied, it failed to bring itself under the beneficent provisions of those statutes. Instead, it maintained a suit upon a claim of group B without filing disclaimers as to the invalid claims of group A.

4. Proposition: Appellant insists that it has a right to be heard by the Supreme Court following a diversity of opinion between two Circuit Courts of Appeals before it must disclaim.

Answer: An argument of this nature was answered in *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445, 453; 51 S. Ct. 207, 209, where the court said:

> "Under this view a patentee having procured allowance of an invalid claim may hold it in the face of the public for years (here nearly two years) with large possible advantage to himself and much injury to others. By the assertion of his apparent monopoly he may deter others from legitimate action and seriously prejudice the public."

Appellant has held claims of group A in the face of the public for over eight years to date and is attempting to maintain a suit upon claims of group B without disclaiming the group A claims.

If there are other points made by appellant, they are hidden among appellant's discussion of the merits of the patent side of the case into which appellee will not follow as it is unnecessary in a consideration of the merits of the disclaimer question upon the certified questions as to the law applicable to the facts of the Record before this Court.

Analysis of Appellant's Citations Urged in Support of Appellant's Point II.

—1—

Expanded Metal Co. v. *Bradford,* 214 U. S. 366; 29 S. Ct. 652.

In this case the patent contained but one claim for a method. It was held invalid in the Circuit Court of Appeals for the Third Circuit and later held valid by the Circuit Court of Appeals for the Sixth Circuit. Writs of certiorari were issued to these Courts of Appeals and the patent invalidated. Here the patentee could not disclaim. *Winans* v. *N. Y. & E. R. R. Co.,* 62 U. S. (21 How.) 88. This is the type of case that appellant is trying to qualify under.

—2—

Diamond Rubber Co. v. *Consolidated Rubber Tire Co.,* 220 U. S. 428; 31 S. Ct. 444.

The patent in this case contained but two claims both of which were upheld or invalidated as a whole in each of the preceding cases most of them involving copending suits. As a matter of fact these claims were first held valid in a series of suits. Both claims of the patent were held invalid in 116 F. 363 (C. C. A. 6) and was followed in 123 F. 85 (C. C. A. 6) as the Supreme Court had denied certiorari to the former case. The facts are identical with the Expanded Metal Case and have no application to the case at bar.

—3—

Dowagiac Manufacturing Company v. *Minnesota-Moline Plow Co.*, 235 U. S. 641; 35 S. Ct. 221.

This case involved a question of accounting following infringement suits favorable to the patent. No facts similar to the instant case were involved.

—4—

Abercrombie & Fitch v. *Baldwin*, 245 U. S. 198; 38 S. Ct. 104.

In the Seventh Circuit claims 1 and 4 of the patent were held invalid and non-infringed. A reissue was procured. The reissue claim 4 was held invalid in the Third Circuit after a trial in the Second Circuit upon the same claim had taken place, but before a decision in that suit. In the Second Circuit a decision was handed down holding claim 4 valid within one month of the Third Circuit decision. The time for filing disclaimers had not yet run even under the decision in *Hoe & Co.* v. *Goss Printing Press Co.*, 31 F. (2d) 565 (C. C. A. 6) at the time of the Second Circuit decision vindicating the plaintiff's position. Appellant had no such vindication. It did not begin to seek vindication until nine months after the invalidating holding (R., p. 3).

—5—

Railroad Supply Co. v. *Elyria Iron & Steel Co.*, 244 U. S. 285; 37 S. Ct. 502.

Preceding this case, infringement suits were copending in District Courts of the Seventh and Sixth Circuits. The District Court of the Seventh Circuit first held the claims of the patent non-infringed. Shortly afterward the District Court in the Sixth Circuit held

the claims invalid. Upon appeal the Court of Appeals for the Sixth Circuit affirmed its District Court and nine months later the Court of Appeals for the Seventh Circuit held the patents to be valid reversing its District Court. Plaintiff's continuity of action is clear. It appealed its cases within time and prosecuted all of these cases to a final conclusion including a petition to the Supreme Court for writ of certiorari to the Sixth Circuit where the claims had been held invalid. The cases were conducted substantially concurrently. It is interesting to note that appellant in the case at bar could have done this with the Cutino Company suit in the Eighth Circuit but did not choose to do this. In the Railroad Supply case there was no gap in plaintiff's continuity. Appellant also might have filed a petition for writ of certiorari to the Seventh Circuit in the case at bar as was done in this Railroad Supply Co. case.

—6—

T. H. Symington Co. v. *National Malleable Castings Co.*, 250 U. S. 383, 39 S. Ct. 542.

This case involved suits in two different Circuits upon similar but different patents for similar subject-matter. The issue before the Supreme Court was the determination of inventorship of the subject-matter of the patents. In the First Circuit the patentee of the patent in suit was held to be the inventor and in the other Circuit the patentee of the patent there in suit was held to be the inventor. The Supreme Court upheld the First Circuit. This case had nothing to do with disclaimers.

—7—

Meccano Limited v. *John Wanamaker,* 253 U. S. 136; 40 S. Ct. 463.

Suit was brought in a District Court of Ohio for patent infringement and on July, 1916, the patent was held valid. Unfair competition was found and an appeal taken. In the meantime a similar suit was brought against Wanamaker in a District Court of New York, December 9, 1916, and a preliminary injunction was granted January 12, 1917, upon the patent and unfair competition phases of the case. An appeal there was also taken. During the pendency of the appeal in the Second Circuit, the Court of Appeals for the Sixth Circuit in November, 1917, found the patent to be invalid but affirmed the unfair competition phase. Plaintiff in both cases then withdrew the patent from the Second Circuit case and moved for a final decision on the merits relative to the unfair competition phase, apparently upon grounds of *res judicata* because of the relationship between the defendants in the two suits. No question relative to disclaimers was involved as the patent was withdrawn in the Second Circuit suit. This case has no bearing upon the facts or the law of the case at bar.

—8—

New York Scaffolding Co. v. *Chain Belt Co.,* 254 U. S. 32; 41 S. Ct. 21.

In the first suit under the patent involved, the Court of Appeals for the Eighth Circuit held the patent valid and infringed, 224 F. 452.

In the second suit the Third Circuit held the patent invalid, 243 F. 577, citing the first suit.

In the third suit in the Seventh Circuit the patent was held valid and infringed, 245 F. 747.

Claims 1 and 3 only were involved in the Third and Seventh Circuit cases. The facts of these cases may also be seen at 254 U. S. 24; 41 S. Ct. 18. The plaintiff was not maintaining his suit in the Seventh Circuit upon claims not previously adjudicated invalid as in the case at bar, but was attempting to vindicate his position only as to claims previously held invalid, 245 F. 474. The facts of the instant case and the New York Scaffolding case are different. The facts of the New York Scaffolding Co. case have not been specifically passed upon by the Supreme Court as to disclaimer.

—9—

John E. Thropp Sons Co. v. *Sieberling,* 264 U. S. 320, 44 S. Ct. 346.

This case is not pertinent to the facts of the present case. Sieberling brought suit upon both the State patent and upon the Sieberling and Stevens patent in both the Sixth and Seventh Circuits. The Sixth Circuit passed upon the patents first, holding the State patent to be void and two claims of the Sieberling *et al.* patent void and one claim non-infringed. Sieberling then filed disclaimers to eight of the State patent claims and qualified disclaimers to the other eleven claims. It dropped the Sieberling and Stevens patent from the Third Circuit case and sued upon the State patent as amended. The Third Circuit upheld the State patent as amended by disclaimers. 284 F. 746. Obviously, nothing to assist in the instant case is found here.

—10—

Corona Tire Co. v. *Doran Chemical Corporation,* 276 U. S. 358; 48 S. Ct. 380.

All claims of the Weiss patent were found to be invalid by the Second Circuit as Weiss was not the inventor. In the Third Circuit Weiss was found to be the inventor and the claims were held valid. Obviously, the facts of the present case are not found here. When the Weiss patent and all of its invalid claims was taken to the Third Circuit, this was not maintaining a suit upon some material or substantial part of the patent not previously adjudicated invalid as in the case at bar. As all of the claims were judicially held invalid the wording of the Disclaimer Statutes did not apply. This is another case under which appellant would like to qualify.

—11—

Saranac Automatic Machine Corp. v. *Wirebound Patents Co.,* 282 U. S. 704; 51 S. Ct. 232.

In an earlier suit in the Seventh Circuit involving claims of the type of claim 25 of patent 1,128,145, the court held that if the patent was of an inventive character, it was not infringed, 25 F. (2d) 363, 365. In the Sixth Circuit, claims of the type of claim 25 were found to be valid. 37 F. (2d) 830. There is nothing to indicate that in the Sixth Circuit case the plaintiff was attempting to set up claims not previously adjudicated invalid. If the Seventh Circuit holding was as to invalidity, from the facts that can be found, the Sixth Circuit suit was upon the same claims. This is not the fact of the instant case.

Radio Corporation v. *Radio Engineering Laboratories,* 239 U. S. 1; 54 S. Ct. 752.

These cases involve the legal duel between DeForest and Major Armstrong. The DeForest claims were never invalidated prior to the Second Circuit decision to which the writ of certiorari was issued in this cited case. Previously, the Second Circuit had affirmatively upheld the Armstrong patent but it had not passed upon the DeForest patent prior to the decisions of the Third Circuit upholding the latter. This case is certainly not pertinent to the facts of the present case.

The facts of these cases are all distinguishable from the facts of the case at bar and from those in the case of *Ensten* v. *Simon, Ascher & Co.,* 282 U. S. 445; 51 S. Ct. 207, upon which appellee strongly relies. These cases cited by appellant in fact bear out the suggestions of appellee that a patentee may do something with his judicially-declared invalid claims in the way of asserting them. When he maintains suit upon other claims of his patent not judicially declared invalid, he comes within the specific wording of the disclaimer statutes and must have complied therewith or his whole patent is void.

Conclusion.

The answer to Question No. 1 should be in the negative. These are facts similar to those of *Hoe & Co.* v. *Goss Printing Press Co.* (C. C. A. 2), 31 F. (2d) 565; *Ensten* v. *Simon, Ascher & Co.,* 282 U. S. 445; 51 S. Ct. 207; and *Liquid Carbonic Co.* v. *Gilchrist* (C. C.

A. 7), 253 F. 54, 58, with the exception that claims previously held invalid were not again joined in those cases as they have been in the instant case.

The answer to Question No. 2 should be in the affirmative in view of the holding by the Supreme Court in *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445, 51 S. Ct. 207, that a delay of nearly two years in filing disclaimers was fatal.

The answer to Question No. 3 should be in the negative as in the Sixth Circuit the suit was again maintained upon parts of the patent not previously declared invalid, without disclaimer of the claims previously held void. The court consequently passed upon the merits of one claim without having the question of disclaimers raised for its judgment. Moreover, after but one claim had been adjudicated valid appellant did not even then disclaim the other claims previously held invalid before proceeding against appellee upon claims not previously adjudicated. Finally, the breach in appellant's continuity of effort by failure to apply for writs of certiorari from the early Seventh Circuit decisions and its further failure to apply for a rehearing in the Sixth Circuit case to have the other claims of group A passed upon was fatal.

Respectfully submitted,

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